

c.) Remarks

Claim 4 and 7 have been amended in order to recite the present invention with the specificity required by statute. Additionally, new Claim 39 is presented in order to more specifically recite various preferred embodiments of the present invention. Accordingly, no new matter has been added.

This amendment follows the RCE filed February 14, 2003 in response to the Office Action dated August 19, 2002 (Paper No. 10) and is within the three month period of suspended proceedings for which Applicant petitioned. If, procedurally the previous paper ought to have been a CPA rather than an RCE, then the Assistant Commissioner is hereby authorized to so construe the earlier filing and to charge any necessary Petition or filing fees thereunder to Deposit Account No. 06-1205.

**Rejection under 35 U.S.C. §102(b):**

Claims 4, 20 and 21 were rejected under 35 U.S.C. §102 as anticipated by Kitamura et al. and Baumgartener et al. In response, claim 4 is amended to clarify that the DNA, which is capable of hybridizing under stringent condition and encompasses a DNA comprising the nucleotide sequence of SEQ ID NO: 1, which has at least 95% homology with the nucleotide sequence of the DNA. The prior art teaches no DNA which satisfies such level of homology.

**Rejection under 35 U.S.C. §103(a)**

Claims 4, 20 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kitamura in view of Nagase et al. (*DNA Research* 5:31-39, 1998) for the reasons set forth in the Office Action.

At the outset, Applicant respectfully wishes to point out that the rejection simply has no basis in law. Whether or not those of ordinary skill would have been motivated to substitute Kitamura's rat brain cDNA library with Nagase's human brain library, or to utilize a rat Nap1 cDNA probe for a mouse brain cDNA probe is, respectfully submitted, entirely off-point. Such is in fact clear per the Federal Circuit, even assuming *arguendo* that there would have been an

expected benefit of isolating the human Nap1 DNA homolog of Kitamura's rat Nap1 DNA... [and that the] ordinary artisan would have been motivated to have used the rat Nap1 DNA as a probe to isolate the human Nap1 homolog because Kitamura et al taught that Nck binding proteins were expected to be involved in ras mediated cancers. (Office Action, page 6, line 19 to page 7, line 1.)

That is, these claims are not directed to methods of fishing out or cloning DNA; the claims are to DNA per se. DNA is a chemical, and the claimed DNA is not structurally obvious from anything taught by Kitamura. Nor is there from Nagase any motivation of record found to make the necessary changes to Kitamura in order to conform its DNA to meet the claimed 95% homology. The process steps discussed from page 6, line 15 to page 7, line 8 of the Office Action are simply irrelevant as a matter of law to the claimed subject matter. In re Deuel, 34 USPQ 1210 (Fed. Cir. 1995).

In any event, the Examiner's rejection also without basis in fact; as described in the specification at page 4, lines 15-17, there was no prior knowledge of the relation between the Nap1 protein and its inhibitory effect on apoptosis prior to the present application. Accordingly, it was not known that the DNA comprising the nucleotide sequence of SEQ ID NO:1 has apoptosis-suppressing activity. Accordingly, respectfully

submitted, those of ordinary skill would not have been motivated to act in conformity with the Examiner's process anyway.<sup>1/</sup>

**Rejection under second paragraph 35 U.S.C. § 112:**

Claims 4, 7, 20 and 21 are rejected under 35 U.S.C. §112, second paragraph. In response, the claims have been amended in order to specifically address the Examiner's noted concern.

**CONCLUSION**

In view of the above amendments and remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.


Claims 2-6, 20, 21 and 39 remain presented for continued prosecution.

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<sup>1/</sup> Moreover, Applicant also notes that Nagase was not published until after Applicants' December 15, 1997 priority date of JP 363183/1997. Accordingly, in order to reduce the issues and expedite prosecution herein, Applicant is obtaining a sworn translation of JP 363183/1997. Such will be filed as quickly as possible, so as to remove Nagase as prior art herein.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Lawrence S. Perry", is written over a horizontal line.

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